

REMARKS

Reconsideration is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Part 1 of the Office Action

Affirmation of the election of the species of embodiment a) of Figure 1, which is covered in the original application filing by claims 1 through 11 and 17 through 19.

Parts 2 and 3 of the Office Action

The specification has been objected to for the informalities noted in the Office Action in paragraph 2.

The drawings have been objected to in paragraph 3.

Submitted under separate cover and addressed to the Examiner is applicant's proposed amendment of the drawing. Specifically, in Figure 2 of the drawings as originally filed, the reference numbers "29" and "30" have been switched in position to agree with the detailed description in the specification, and therefore no amendment of the specification is deemed to be required.

Also, in Figure 6, reference number "42" has been replaced by "44", and reference number "42" has been added with a lead arrow designating the loop in Figure 6 generally.

In light of the proposed drawing amendment, it is therefore submitted that the objection to the drawings as originally filed has been overcome, and withdrawal of the objections to the specification and the drawings is respectfully requested.

Part 4 of the Office Action

Claim 8 has been objected to for the informalities noted in the Office Action.

Claim 8 has been amended to depend from claim 7, which is believed to clarify any informalities.

Withdrawal of the objection to claim 8 is therefore respectfully requested.

Part 5 of the Office Action

Claims 17 and 18 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 17 and 18 is therefore respectfully requested.

Part 6 of the Office Action

Claims 1 through 5, 7, 9 through 11, 17 and 18 have been rejected under 35 U.S.C. §102(b) as being anticipated by Quackenbush (5,072,542).

Claim 1, particularly as amended, requires “a securing portion forming a hook for securing an ornamental item to the mounting portion, the hook opening toward a side edge of the mounting portion such that the hook portion is orientatable upwardly when the mounting portion grips a vertically extending portion of the pew support”. The securing portion that forms a hook with the claimed orientation is submitted to be especially for holding items onto a vertically-extending structure, such as a pew support, in combination with the mounting portion set forth in claim 1. The claimed orientation of the opening of the hook provides a secure holding means for ornamental items hooked on the securing portion.

The Quackenbush reference teaches a gravestone saddle planter in which tabs 21 extend generally parallel to the rest of the bracket 12. Thus, if the bracket 12 were to be embraced about a vertically-extending member, each of the tabs 21 would extend horizontally sideways, and any opening that may be defined by the tabs would open sideways, which would be largely ineffective for hooking onto an item. Significantly, the gravestone saddle planter of Quackenbush is intended to be (and is therefore is designed for) positioning on the generally horizontal top surface of a gravestone. See, e.g., the Summary of the Invention of Quackenbush at col. 1, lines 66 through 68:

It is a further object of this invention to provide a holder which is readily attached and removed from the top surface of a gravestone.

It is therefore submitted that the structure of the Quackenbush bracket, and the environment of the application of the Quackenbush invention, would not lead one of ordinary skill in the art to a structure having the requirements set forth in claim 1, especially as amended.

Further, claim 10 requires "wherein the securing arm has a first end mounted on the mounting portion and a second end being free of connection to the mounting portion, the second end being biased against the outer face of the mounting portion". This feature of the claimed invention provides a more secure holding of ornamental items between the securing arm and the mounting portion of the clip. Clearly this is completely foreign to the teaching of Quackenbush, as the tabs of Quackenbush extend nowhere near the middle portion (unnamed and unnumbered) of Quackenbush, and such a relationship as is claimed would prevent the mounting of the container 11 of the Quackenbush invention on

the bracket 12 of Quackenbush.

Claim 17 requires, in part, "a securing portion for removably securing an ornamental item on the mounting portion, the securing portion having a first end being mounted on the mounting portion and a second end free of connection to the mounting portion and being biased against the outer face of the mounting portion". This claim, which includes requirements similar to that of claim 10, is also submitted to be allowable in view of the remarks made above with regard to claim 10.

Withdrawal of the §102(b) rejections of claims 1 through 5, 7, and 9 through 11, and 17 through 18 is therefore respectfully requested.

Part 7 of the Office Action

Claims 6, 8 and 19 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Quackenbush (5,072,542).

Claim 6 has been written into independent form such that it includes the requirements of claim 6 as originally filed in this application.

Claim 6 (and claim 19) requires that each of the free end extents extends inwardly from one of the return extents and is oriented generally perpendicular to the longitudinal extent.

Claim 8 (and claim 19) requires that the gap formed between the end edge on the free end extent and the longitudinal extent and a distance of the gap is approximately one-half of a distance of a farthest extent of the return extents from the longitudinal extent.

The Office Action admits that these claimed relationships are not shown in the prior art, and particularly by the Quackenbush

teaching, but alleges that it is "the design choice of the applicant and is not a critical requirement of the invention". The Office Action then makes the assertion that "it would have been obvious... to make the extents by Quackenbush longer and perpendicular in order to make the extents have an even tighter fit onto the object it is mounted to".

With regard to the matter of these relationships being merely a matter of design choice, it is noted that the Federal Circuit has spoken on the issue of when the allegation of "design choice" is not correct:

From the totality of the record, we hold that placement of the SCR catalyst within the bag retainer would not have been merely a matter of "design choice." First, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the Szymanski structure to place the SCR catalyst within a bag retainer as opposed to between two filter bags as disclosed in Szymanski. Next, Chu's technical evidence relating to the frailty of fabric filters during pulse-jet cleaning clearly counters the assertion that placement of the catalyst in the baghouse is merely a "design choice." Specifically, Chu's evidence regarding the violent "snapping" action during pulse-jet cleaning, the difficulty in stitching compartments including the capacity to withstand high temperatures, and problems encountered from variable path lengths due to settling of the catalyst particles in each compartment militates against a conclusion that placement of the SCR catalyst is merely a "design choice." See *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of "obvious design choice" precluded where the claimed structure and the function it performs are different from the prior art).

In re Chu, 36 USPQ 2d 1089, 1095 (Fed. Cir. 1995) (emphasis added)

Thus, if the prior art does not motivate the modification of the prior art structure to achieve the claimed structure, and there is a benefit that is associated with the claimed structure over the prior

art structure, the claimed structure cannot be dismissed as “merely a design choice”.

As to the first issue of motivation in the prior art to make the modification, it is noted that the Quackenbush reference discloses a pair of pads 22 located near the ends of the bracket 12.

Quackenbush teaches, for example, at col. 3, lines 42 through 53 (emphasis added):

Pads 22, made of a resilient sponge or foam material, are fixedly attached with glue or the like to resilient bracket 12 as shown so that bracket 12 can rest upon the top of a gravestone with surface G contacting the top of the gravestone and pads 22 contacting the front and rear surfaces of the gravestone to protect the gravestone from marring, marking or scratching. Pads 22 are also designed to provide a frictional gripping action with respect to the front and rear surface of a gravestone, thereby securing the saddle planter on top of the gravestone, even under adverse conditions such as high wind and heavy rains.

In view of this disclosure in Quackenbush, it is submitted that one of ordinary skill in the art, considering the Quackenbush teaching, would be led to employing the pads 22 of Quackenbush on the bracket 12 in order to enhance gripping of the gravestone, rather than having any motivation to make the legs of the bracket 12 longer. In other words, one of ordinary skill in the art considering the Quackenbush patent would choose to enhance the gripping ability of the bracket through the pads 22 (as explicitly taught by Quackenbush). It is further noted that any attempt to extend the legs of Quackenbush so that the legs of the bracket are longer, or some portion of the legs is oriented perpendicular to the major portion of the bracket, would most likely move the pads 22 out of possible contact with the surface of the gravestone, and thus render them useless for the purpose for which they are intended by Quackenbush. Certainly one of ordinary skill in the art would not

modify the Quackenbush bracket in a manner that render the pads useless.

Turning to the second issue, whether the claimed structure has a benefit over the prior art structure, the relationships set forth in claims 6, 8 and 19 permit the clip of the claimed invention to achieve a tighter grip on, for example, the end of a pew. The benefit of these relationships is set forth, for example, in the applicant's specification at page 9 in the first paragraph. The Examiner, having the benefit of the applicant's disclosure, has also recognized that the claimed structure is beneficial for permitting a more secure hold on a structure such as a pew.

Further, claim 19 requires "the second end of the securing arm being biased against the mounting portion", which, for the reasons set forth above with regard to claim 10, is submitted to provide a further distinction between the invention of claim 19 and the Quackenbush disclosure.

It is therefore submitted that the prior art, and especially the Quackenbush patent, relied upon in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 6, 8 and 19.

Withdrawal of the §103(a) rejection of claims 6, 8, and 19 is therefore respectfully requested.

Added claims

Added claim 20 requires that the hook of claim 1 comprise a securing arm with a first end mounted on the mounting portion and a second end free of the mounting portion, and that *the second end of the securing arm extends toward one of the side edges of the mounting portion* (emphasis added). It is submitted that the prior

art, and especially the Quackenbush teaching, would not lead one of ordinary skill in the art to the relationships and orientations required by added claim 20.

Added claim 21 requires that the securing arm of claim 20 *extends past* one of the side edges of the mounting portion (emphasis added). The benefits associated with this relationship are set forth, for example, at page 10 of the specification on lines 16 through 24. Again, it is submitted that the prior art, including Quackenbush, would not motivate one of ordinary skill in the art to arrive at the relationship required by claim 21.

Added claim 22 requires that one of the side edges of the mounting portion of claim 20 defines a plane, and that the securing arm *extends through the plane of the side edge* (emphasis added). It is further submitted that the prior art does not lead one of ordinary skill in the art to such a relationship.

Added claim 23 requires that one of the side edges of the mounting portion define a plane, and that the securing arm extends in a direction oriented substantially perpendicular to the plane of the side edge. This requirement of orientation is not found in the prior art, and certainly Quackenbush would not lead one of ordinary skill in the art to this relationship.

And finally, added claim 24 requires that a major portion of the securing arm extends generally in a plane oriented substantially parallel to the longitudinal extent of the mounting portion. Again, this is strange to the teaching of Quackenbush, and the prior art.

Allowance of added claims 20 through 24 is therefore respectfully requested.

VERSION WITH MARKINGS TO SHOW CHANGES MADE:

In the Claims (bracketed parts deleted and underline parts added):

1. (Amended) A clip for supporting ornamental items on a pew, comprising:

a mounting portion for gripping a portion of a pew support, the mounting portion having a pair of opposite faces including an inner face and an outer face, the mounting portion having a pair of side edges and a pair of end edges, the mounting portion comprising:

an elongate longitudinal extent having opposite end regions;

a pair of transverse extents, each of the transverse extents extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent;

a pair of return extents, each of the return extents extending from one of the transverse extents, each of the return extents extending towards each other; and

a pair of free end extents, each of the free end extents extending from one of the return extents; and

a securing portion forming a hook for securing an ornamental item to the mounting portion, the hook opening toward a side edge of the mounting portion such that the hook portion is orientatable upwardly when the mounting portion grips a vertically extending portion of the pew support.

2. (Pending) The clip of claim 1 wherein the pair of transverse extents extend outwardly from the inner face of the longitudinal extent, each of the transverse extents having opposite end regions, a first one of the end regions of each of the transverse

extents being joined to one of the end regions of the longitudinal extent.

3. (Pending) The clip of claim 1 wherein each of the return extents extends generally parallel to the longitudinal extent, each of the return extents extending from a second one of the end regions of one of the transverse extents.

4. (Pending) The clip of claim 1 wherein each of the transverse extents and each of the return extents are arcuate.

5. (Pending) The clip of claim 4 wherein each of the free end extents is arcuate such that a group of connected transverse, return and free end extents forms a portion of a circle.

6. (Amended) [The] A clip [of claim 1] for supporting ornamental items on a pew, comprising:

a mounting portion for gripping a portion of a pew support, the mounting portion having a pair of opposite faces including an inner face and an outer face, the mounting portion having a pair of side edges and a pair of end edges, the mounting portion comprising:

an elongate longitudinal extent having opposite end regions;

a pair of transverse extents, each of the transverse extents extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent;

a pair of return extents, each of the return extents extending from one of the transverse extents, each of the return extents extending towards each other; and

a pair of free end extents, each of the free end extents

extending from one of the return extents;

wherein each of the free end extents extends inwardly from one of the return extents, each of the free end extents being oriented generally perpendicular to the longitudinal extent.

7. (Pending) The clip of claim 1 wherein each of the end edges of the mounting portion is located on one of the free end extents, and a gap is formed between the end edge on the free end extent and the longitudinal extent.

8. (Amended) The clip of claim [8] 7 wherein a distance of the gap is approximately one-half of a distance of a farthest extent of the return extents from the longitudinal extent.

Cancel claim 9.

10. (Amended) The clip of claim [9] 1 wherein [the securing portion comprises a securing arm for holding a portion of an ornamental item against the mounting portion,] the securing arm [having] has a first end mounted on the mounting portion and a second end being free of connection to the mounting portion, the second end being biased against the outer face of the mounting portion.

11. (Amended) The clip of claim [10] 1 wherein the securing arm generally converges toward the outer face at the second end thereof to form a channel therebetween for receiving a portion of an ornamental item.

Claims 12 through 16 have been withdrawn without prejudice as being directed to a non-elected invention.

17. (Amended) A clip for supporting ornamental items on a

pew, comprising:

a mounting portion for gripping a portion of a pew support, the mounting portion having a pair of opposite faces including an inner face and an outer face, the mounting portion having a pair of side edges and a pair of end edges, the mounting portion comprising:

an elongate longitudinal extent having opposite end regions;

a pair of transverse extents, each of the transverse extents extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent;

a pair of [free end] return extents, each of the [free end] return extents being connected to one of the [return] transverse extents, each of the [free end] return extents extending [toward the longitudinal extent] towards each other;

and

a securing portion for removably securing an ornamental item on the mounting portion, the securing portion having a first end being mounted on the mounting portion and a second end free of connection to the mounting portion and being biased against the outer face of the mounting portion.

18. (Amended) The clip of claim 17 wherein the mounting portion includes a pair of [return] free end extents, each of the [return] free end extents extending between one of the transverse extents and one of the free end extents, each of the return extents extending from one of the transverse extents and towards each other.

19. (Amended) A clip for supporting ornamental items on a pew, comprising:

a mounting portion for gripping a portion of a pew support, the mounting portion having a pair of opposite faces including an inner face and an outer face, the mounting portion having a substantially uniform width, the mounting portion having a substantially uniform thickness, the mounting portion being formed of a resiliently flexible material, the mounting portion having a pair of side edges, the pair of side edges being oriented substantially parallel to each other, the mounting portion having a pair of end edges, the pair of end edges each extending substantially perpendicularly to the side edges, the mounting portion comprising:

- an elongate longitudinal extent having opposite end regions, the longitudinal extent being substantially planar;

- a pair of transverse extents, each of the transverse extents extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent, the pair of transverse extents extending outwardly from the inner face of the longitudinal extent, each of the transverse extents being arcuate, each of the transverse extents having opposite end regions, a first one of the end regions of each of the transverse extents being joined to one of the end regions of the longitudinal extent;

- a pair of return extents, each of the return extents extending from one of the transverse extents, each of the return extents extending towards each other, each of the return extents extending generally parallel to the longitudinal extent, each of the return extents extending from a second one of the end regions of one of the transverse extents, each of the return extents being arcuate; and

- a pair of free end extents, each of the free end extents extending from one of the return extents, each of the free end extents extending inwardly from one of the return extents,

each of the free end extents being oriented substantially perpendicular to the longitudinal extent, each of the end edges of the mounting portion being located on one of the free end extents, a gap being formed between the end edge on the free end extent and the longitudinal extent;

wherein a distance of the gap being approximately one-half of a distance of a farthest extent of the return extents from the longitudinal extent; and

a securing portion for removably securing an ornamental item on the mounting portion, the securing portion being mounted on the mounting portion, the securing portion being located on the outer face of the mounting portion, the securing portion comprising a securing arm for holding a portion of an ornamental item against the mounting portion, the securing arm having a first end mounted on the mounting portion and a second end being free of connection to the mounting portion, the securing arm generally converging toward the outer face at the second end thereof to form a channel therebetween for receiving a portion of an ornamental item, the second end of the securing arm being biased against the mounting portion.

Please add the following claims:

20. (Added) The clip of claim 1 wherein the hook comprises a securing arm with a first end mounted on the mounting portion and a second end free of the mounting portion, the second end of the securing arm extending toward one of the side edges of the mounting portion.

21. (Added) The clip of claim 20 wherein the securing arm extends past one of the side edges of the mounting portion.

22. (Added) The clip of claim 20 wherein one of the side edges of the mounting portion defines a plane, and the securing arm extends through the plane of the side edge.

23. (Added) The clip of claim 20 wherein one of the side edges of the mounting portion defines a plane, and the securing arm extends in a direction oriented substantially perpendicular to the plane of the side edge.

24. (Added) The clip of claim 20 wherein a major portion of the securing arm extends generally in a plane oriented substantially parallel to the longitudinal extent of the mounting portion.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,



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